

REMARKS

Amendments to the Claims

Applicants presently amend claim independent 1 to recite wherein the PLSC records to be downloaded include priority “and duration,” “storing the downloaded PLSC records in a PLSC queue,” and “selecting from the PLSC queue a PLSC record having a duration equal to or less than a duration for a next interleave slot indicated in a broadcast schedule for the broadcast content.” Support for these amendments can be found in Applicants’ Original Specification at page 13, lines 3-11. Although Applicants have amended claim 1 to include additional limitations, Applicants do not concede that claim 1 as originally filed is not patentable over the art cited by the Office Action. In fact, Applicants reserve the right to pursue these originally filed claims in one or more continuation applications. Applicants submit that the amendments introduce no new matter into the case, and that the claims are in condition for allowance.

Claim Rejections – 35 U.S.C. § 103 Over Lee In View Of Ellis And Welk

Claims 1-4, 6-9, 11-12, and 14-16 stand rejected under 35 U.S.C. § 103 as unpatentable over Lee, *et al.* (U.S. Patent 6,829,475) (hereafter ‘Lee’) in view of Ellis, *et al.* (U.S. Patent 7,185,355) (hereafter ‘Ellis’) and Welk, *et al.* (U.S. Patent 5,828,585) (hereafter ‘Welk’). The question of whether Applicants’ claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-1730, 82 USPQ 1385 (2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Applicants’ claims for obviousness under 35 U.S.C. § 103. *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a prima facie case of obviousness, the proposed combination of Lee, Ellis, and Welk must teach or suggest all

of Applicants' claim limitations. MPEP 2142 (citing *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974)). As shown below in more detail, the proposed combination of Lee, Ellis, and Welk cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application. As such, Applicants respectfully traverse each rejection individually.

Independent claim 1 of the present application, as amended, recites:

1. A method of providing preferred location specific content for interleaving into broadcast content, the method comprising the steps of:
 - storing user preferences in user preference records in a content server;
 - storing location specific content (LSC) in LSC records in the content server, wherein LSC records comprise data elements comprising digital content, content type, target location, duration, relevant date range, and relevant time range;
 - receiving, from a digital communications network, a location of a user client device;
 - determining local date and time at the location of the user client device;
 - storing more than one indication of the location of the user client device and, associated with each such indication of location of the user client device, the local time when the user client device was at the location;
 - calculating, in dependence upon the stored indications of location and time, a speed of the user client device and a direction of travel of the user client device;

creating preferred location specific content (PLSC) records in the content server, the creating carried out in dependence upon the LSC records, the user preferences, the location of the user client device, and the local date and time at the location of the client device, further comprising creating preferred location specific content (PLSC) records in dependence upon the user preferences, the location of the user client device, the local date and time at the location of the client device, and the speed and direction of travel of the user client device;

downloading the PLSC records through the digital communications network from the content server to the user client device, wherein the PLSC records to be downloaded include priority and duration, and downloading the PLSC to the user client device further comprises:

downloading the PLSC to the user client device in dependence upon priority; and

excluding priority from the downloaded PLSC records;

storing the downloaded PLSC records in a PLSC queue; and

selecting from the PLSC queue a PLSC record having a duration equal to or less than a duration for a next interleave slot indicated in a broadcast schedule for the broadcast content.

**The Proposed Combination Of Lee, Ellis And Welk
Neither Discloses Nor Suggests Downloading PLSC
To A User Client Device In Dependence Upon Priority**

The Office Action takes the position that Lee at column 12, lines 13-18 and column 11, lines 44-52 discloses the following limitation of claim 1: downloading the PLSC to the user client device in dependence upon priority. Applicants respectfully note in response, however, that what Lee at column 12, lines 13-18 in fact discloses is:

The gateway 30 further transmits events to the vehicle based on preferences provided by the user in a user profile stored on a stand alone personal computer 206. Such events could be, for example, stock market alerts (i.e., set an alert when a stock reaches a set value), traffic alerts based upon the user's route (notifies of any delays as they happen in real time on the route), email messages, or the like.

That is, Lee at column 12, lines 13-18 discloses providing real time traffic alerts to a user based on user preferences. Applicants also respectfully note in response that what Lee at column 11, lines 44-52 in fact discloses is:

Information in advertising databases can be compared against a user's purchasing interest profile through an adaptive profiler 200 so that advertisements inserted into delayed personalized digital broadcasts mesh with that individual's buying interests. If there are multiple users on one account (e.g., family members) then each user will preferably have a unique profile in the user database 198.

That is, Lee at column 11, lines 44-52 discloses inserting advertisements into delayed personalized digital broadcasts that mesh with the user's buying interests. Regarding these portions of Lee, the Office Action states:

Traffic alerts are provided to the user in real time when there is a traffic delay on the user's route (col. 12, lines 13-18). Delayed personalized digital broadcasts are also provided to the user (col. 11, lines 44-52). Unlike personalized digital broadcasts, traffic alerts have higher priority since they are provided in real time as opposed to a later time.

Applicants understand the Office Action as asserting that by disclosing real time traffic alerts and delayed personalized digital broadcasts, which are not provided in real time, Lee is disclosing downloading PLSC to a user client device in dependence upon priority. Applicants respectfully disagree with this assertion. "Priority" as claimed in the present application includes single-field indications of priority as well as more complex indications of PLSC record type and content. *See*, Applicants' Original Specification at page 18, line 27 to page 19, line 2. Lee makes no such disclosure of either single field indications of priority or of more complex indications of PLSC record type and content. In an attempt to remedy this deficiency in Lee, the Office Action tries to infer "priority" as claimed from the fact that Lee discloses both real time as well as delayed broadcasts.

Applicants contend that such an inference is impermissible, because it would not occur to one of ordinary skill in the art. In evaluating whether prior art discloses a claim limitation, only “the inferences and creative steps that a person of ordinary skill in the art would employ” are permitted. MPEP § 2141 (citing *KSR*, 82 USPQ2d at 1396); *See also In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Lee’s traffic alerts, which are based on a user’s route present in a user profile, must be provided in real time as opposed to a later time, because to provide them at a later time would render them meaningless to the user, who will have already navigated the route. That is, Lee is compelled by the nature of the traffic alerts themselves to provide the traffic alerts in real time. Being forced to provide traffic alerts in real time while providing other items at a later time, however, does not equate to *prioritizing* the traffic alerts over the other items. Furthermore, a person of ordinary skill in the art would not infer single field indications of priority as well as more complex indications of PLSC record type and content from such disclosures in Lee. A person of ordinary skill in the art would thus not infer “priority” as claimed from Lee’s disclosures. As such, Lee’s disclosures do not disclose or suggest downloading the PLSC to the user client device in dependence upon priority. The combination of Lee, Ellis, and Welk therefore does not disclose or suggest each and every element of the claims of the present application. The Office action therefore cannot establish a *prima facie* case of obviousness. The rejections under 35 U.S.C. § 103 should be withdrawn, and the claims should be allowed.

**The Proposed Combination Of Lee, Ellis And Welk
Neither Discloses Nor Suggests Storing
Downloaded PLSC Records In A PLSC Queue**

As amended, claim 1 of the present application recites “storing the downloaded PLSC records in a PLSC queue.” The Office Action does not state that Lee, Ellis, or Welk disclose this limitation. Furthermore, Applicants respectfully note that at no point in any of the references does Lee, Ellis, or Welk disclose storing downloaded PLSC records in a PLSC queue. In contrast to the claimed limitation, Lee instead discloses in general saving enhanced information contained in content sent to a wireless communication device. Ellis discloses in general a program guide system with preference profiles. Welk

discloses in general vehicle speed signal calibration. Lee, Ellis, and Welk, however, are not concerned with and do not teach storing downloaded PLSC records in a PLSC queue. In fact, none of Lee, Ellis, or Welk even mentions the term 'queue.' Because none of Lee, Ellis, or Welk discloses storing downloaded PLSC records in a PLSC queue, the references alone or in combination fail to teach each and every element of Applicants' claims. The Office Action therefore cannot establish a prima facie case of obviousness. The rejections under 35 U.S.C. § 103 should be withdrawn, and the claims should be allowed.

**The Proposed Combination Of Lee, Ellis And Welk
Neither Discloses Nor Suggests Selecting From A PLSC
Queue A PLSC Record Having A Duration Equal To
Or Less Than A Duration For A Next Interleave Slot Indicated
In A Broadcast Schedule For The Broadcast Content**

As amended, claim 1 of the present application recites "selecting from the PLSC queue a PLSC record having a duration equal to or less than a duration for a next interleave slot indicated in a broadcast schedule for the broadcast content." The Office Action does not state that Lee, Ellis, or Welk disclose this limitation. Furthermore, Applicants respectfully note that at no point in any of the references does Lee, Ellis, or Welk disclose selecting from a PLSC queue a PLSC record having a duration equal to or less than a duration for a next interleave slot indicated in a broadcast schedule for broadcast content. In contrast to the claimed limitation, Lee instead discloses in general saving enhanced information contained in content sent to a wireless communication device. Ellis discloses in general a program guide system with preference profiles. Welk discloses in general vehicle speed signal calibration. Lee, Ellis, and Welk, however, are not concerned with and do not teach selecting from a PLSC queue a PLSC record having a duration equal to or less than a duration for a next interleave slot indicated in a broadcast schedule for broadcast content. In fact, neither Lee nor Welk even mentions the term 'duration.' Furthermore, although Ellis mentions the term 'duration' once, at column 4, line 43, Ellis only discloses that television program listings data can include the duration for a broadcast. Ellis does not disclose comparing that duration to the duration of a next interleave slot indicated in a broadcast schedule for broadcast content. Because none of

Lee, Ellis, or Welk discloses selecting from a PLSC queue a PLSC record having a duration equal to or less than a duration for a next interleave slot indicated in a broadcast schedule for broadcast content, the references alone or in combination fail to teach each and every element of Applicants' claims. The Office Action therefore cannot establish a prima facie case of obviousness. The rejections under 35 U.S.C. § 103 should be withdrawn, and the claims should be allowed.

Relation Between Claims

Independent claim 1 claims method for providing preferred location specific content for interleaving into broadcast content. Claim 1 is allowable for the reasons set forth above. Dependent claims 2-4, 6-9, 11-12, and 14-16 depend from independent claim 1. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Lee, Ellis, and Welk does not teach or suggest each and every element of claim 1, the combination of Lee, Ellis, and Welk also does not teach or suggest each and every element of claims 2-4, 6-9, 11-12, and 14-16. The Office Action therefore cannot establish a prima facie case of obviousness with respect to claims 2-4, 6-9, 11-12, and 14-16. The rejections of claims 2-4, 6-9, 11-12, and 14-16 under 35 U.S.C. § 103 should be withdrawn, and the claims should be allowed.

Conclusion

Claims 1-4, 6-9, 11-12, and 14-16 stand rejected under 35 U.S.C. § 103 as unpatentable over the proposed combination of Lee, Ellis, and Welk. For the reasons set forth above, however, the proposed combination of Lee, Ellis, and Welk fails to establish a prima facie case of obviousness with respect to claims 1-4, 6-9, 11-12, and 14-16. Claims 1-4, 6-9, 11-12, and 14-16 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-4, 6-9, 11-12, and 14-16.

The Commissioner is hereby authorized to charge or credit Deposit Account No.09-0447 fees required or overpaid.

Respectfully submitted,

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By:



H. Artoush Ohanian
Reg. No. 46,022
Biggers & Ohanian, LLP
P.O. Box 1469
Austin, Texas 78767-1469
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS